

CUSTOMER NO.: 24498**Serial No.: 10/567,677****Office Action dated: December 24, 2008****Response dated: March 16, 2009****PATENT
PU030178****REMARKS**

The Office Action mailed December 24, 2008 has been reviewed and carefully considered. No new matter has been added.

At the time of filing, the claim numbering inadvertently skipped from Claim 11 to Claim 14, thus omitting Claims 12 and 13. Hence, in accordance with the statement by the Examiner on page 2 of the Office Action that "[m]isnumbered claims 14-20 have been renumbered 12-18", by this amendment Claims 14-20 have been explicitly renumbered to now be Claims 12-18. Hence, any reference to the pending claims of the instant application hereinafter will refer to the renumbered claims, i.e., Claims 1-18, with the exception of reproducing the Examiner's rejections below from the pending Office Action with respect to 35 U.S.C. 102(e) and 35 U.S.C. 103(a).

Claims 1-5 and 7-18 have been amended. Claims 1-18 are pending.

It is to be noted that the independent claims in the case are Claims 1, 7, and 13.

Claims 1-6 and 15-20 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Publication No. 2004/0205158 to Hsu (hereinafter "Hsu"). Claims 7-11 and 14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu in view of U.S. Patent Publication No. 2004/0097260 to Stenton et al. (hereinafter "Stenton"). The rejections are respectfully traversed.

It is respectfully asserted that neither Hsu nor Stenton, either taken singly or in combination, teach or suggest "transmitting a request to a wireless service provider of a wireless network for a location of a wireless local area network (WLAN)", as recited in Claim 1.

Moreover, it is respectfully asserted that neither Hsu nor Stenton, either taken singly or in combination, teach or suggest "a controller for processing a request over said wireless network for a location of a wireless local area network WLAN and processing receiving over said wireless network said location of said wireless local area network WLAN" as recited in Claim 7.

Further, it is respectfully asserted that neither Hsu nor Stenton, either taken singly or in combination, teach or suggest "a mobile device for sending a request from said wireless service area across said wireless network for a location of a wireless local area network WLAN" as recited in Claim 13

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It is respectfully pointed out to the Examiner that only Hsu was cited against the above reproduced limitations of Claims 1, 7, and 13.

Hsu simply discloses that a base transceiver system "BTS periodically broadcasts WLAN provisioning information (e.g., 802.11a/b frequencies, ESSID, preferred roaming list, etc.) as overhead messages via common channels" (see, e.g., Hsu, para. [0043]). Clearly, a BTS broadcasting WLAN provisioning information as overhead messages via common channels does not correspond to a request to a wireless service provider of a wireless network for a location of a WLAN as recited in Claim 1, or a request over said wireless network for a location of a wireless local area network WLAN as recited in Claim 7, or a request from said wireless service area across said wireless network for a location of a wireless local area network WLAN as recited in Claim 13. That is, in contrast to a specific and explicit request for a location of a WLAN, Hsu teaches that a BTS periodically broadcasts WLAN provisioning information (that is NOT disclosed as including the location of a WLAN) as overhead messages. While it is clear that such WLAN provisioning information does not include the location of a WLAN, even assuming arguendo that it did, Hsu would have no need for a mobile terminal to issue a request for a WLAN location given the periodic broadcasting. Moreover, it is to be noted that Hsu further discloses at paragraph [0038] that "the list of ESSIDs may correspond to a list of WLAN operators accessible by the MS." However, a name(s) of a WLAN operator(s), as per the ESSIDs, does not correspond to a location(s) of a WLAN(s) as recited in Claims 1, 7, and 13.

Moreover, while Hsu also discloses in paragraphs [0045] and [0046] that the WLAN provisioning information may be sent via signaling messages triggered on receipt of a registration message indicating an MS with WLAN capability, a registration message is not a request for a location of a WLAN but rather is a request to register a capability of being able to communicate with a WLAN in the first place and not for a location of a WLAN.

Hence, based on at least the above reasons, it is respectfully asserted that Hsu does not teach or suggest the above reproduced limitations of Claims 1, 7, and 13. Moreover, it is respectfully asserted that Stenton does not cure the deficiencies of Hsu, and is silent with respect to the above reproduced limitations of Claims 1, 7, and 13.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP §2131,

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citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art" (MPEP §2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious" (MPEP §2143.03, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Thus, Claims 1, 7, and 13 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above.

Claims 2-6, 8-12, and 14-18 directly or indirectly depend from Claims 1, 7, and 13, respectively, and, thus, respectively include all the limitations of Claims 1, 7, and 13. Accordingly, Claims 2-6, 8-12, and 14-18 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above with respect to independent Claims 1, 7, and 13, respectively.

Accordingly, reconsideration of the rejections is respectfully requested.

In view of the foregoing, Applicants respectfully request that the rejection of the claims set forth in the Office Action of December 24, 2008 be withdrawn, that pending Claims 1-18 be allowed, and that the case proceed to early issuance of Letters Patent in due course.

It is believed that no further additional fees or charges are currently due. However, in the event that any additional fees or charges are required at this time in connection with the application, they may be charged to applicants' Deposit Account No.07-0832.

Respectfully submitted,

By:


Jeffrey D. Hale

Patent Operations
Thomson Licensing LLC
P.O. Box 5312
Princeton, NJ 08543-5312

Jeffrey Hale, Attorney for Applicants
Registration No.: 40,012

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